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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,315	04/26/2000	SANDRINE DECOSTER	057250553	2035
7590	11/01/2004			
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER 1300 I STREET NW WASHINGTON, DC 20005			EXAMINER CHANNAVAJALA, LAKSHMI SARADA	
			ART UNIT 1615	PAPER NUMBER

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/509,315

**Applicant(s)**

DECOSTER ET AL.

**Examiner**

Lakshmi S Channavajjala

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17 and 21-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/22/04</u> | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Receipt of Remarks and IDS dated 6-22-04 is acknowledged.

Claims 17, 20, 21 and 23-36 are pending in the instant application.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6-22-04 has been entered.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 17, 20, 21 and 23-36 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 17, 20, 21 and 23-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,159,914. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant detergent and conditioning composition containing anionic surfactant and the conditioning system comprising a cationic polymer and an aminosilicone polymer are also claimed in the above patent. The above patent claims a detergent composition comprising specific anionic surfactants and conditioning polymers in the generic claim, and the dependent claims recite aminosilicone of the instant claims. Instant claims differ from the patented claims in the presence of the molecular weight of aminosilicone, 11,000 to 25,000, whereas the patented claims recite a molecular weight range of 5,000 to 500,000. However, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use an aminosilicone having a molecular weight anywhere in the range of 5000 to 500,000, including the claimed range, and still expect effective washing and conditioning with the composition of '914.

***Claim Rejections - 35 USC § 103***

Claims 17, 20, 21 and 23-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/06403 to Reich (WO) in view of GB 2,058,103 (PTO-1449).

Instant claim 17 is directed to a detergent and conditioning composition comprising, a cosmetically acceptable medium, 4% to 50% anionic surfactant, and a conditioning system that comprises at least one cationic polymer and one amine-containing silicone polymer having a molecular weight of 11,000 to 25,000. Claim 20-21 further limits the amounts of anionic surfactant. Claims 23-26 further limit the amounts of amine-containing silicone. Claims 27-30

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limits the amounts of cationic polymer. Claim 31 recite specific cationic polymers i.e., cyclopolymer. Claim 32 recite a quaternary cellulose derivative. Claim 33 recite cationic polysaccharides such as modified guar gums. Claim 34 recites pH 3-10. Claims 35-36 are directed to a process of using instant composition.

WO teaches hair-conditioning shampoos containing 0.01% to 5% cationic polymer, 5% to 40% anionic surfactant, 0.1% to 10% hair conditioning amino functional silicone polymer and a dispersing agent. Further, WO discloses the cationic polymer of the instant claim 31 i.e., a copolymer of acrylamide and dialkyldiallylammonium salt and in the same amounts (abstract, pages 3-4). WO also teaches dispersing agents such as quaternized derivatives of polysaccharides, including hydroxyethyl cellulose, guar gums cationic guar gum or Polymer JR (page 10, lines 13-16). Instant specification, page 15, lines 16-24 state that JR polymers are quaternary ammoniums of hydroxy ethylcellulose which has reacted with an epoxide substituted by a trimethylammonium group. Accordingly, the JR polymers of WO meet the requirement of instant claim 33 i.e., modified guar gums. WO teaches that aminosilicones are more effective as conditioning agents than the conventional silicones and is hence a preferred conditioning agent. With respect to the molecular weights claimed, WO teaches the variables x is 200 to 10,000 and y is 1 to 10; and further states that if x is 797 and y is 1, the molecular weight is about 60,000. WO fails to specify the range of molecular weights for aminosilicones as claimed.

GB teaches a hair conditioning composition comprising a silicone polymer and a cationic polymer, wherein the silicone polymer is an amine silicone (page 1, lines 11-29) having a molecular weight in the range of 5,000 to 100,000. GB teaches that a combination of

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aminosilicone with the above molecular weight range and a cationic polymer enhances the hair conditioning efficiency of the composition (page 1, lines 30-35). Examiner notes that both WO and GB teach the same cationic polymers, which are also described in the instant specification (page 26). Thus, both WO and GB recognize that a combination of aminosilicones and cationic polymer is important for hair conditioning. Further, GB teaches that aminosilicones having a molecular weight in the range of 5000 to 100000 is effective. Accordingly, it would have been obvious for one of ordinary skill in the art at the time of the instant invention to choose a aminosilicone having an appropriate molecular weight in the range of 5000 to 100000, such that the desired conditioning effect is still achieved. Further, absent criticality, adjusting the pH of a hair conditioning composition close to that tolerated by hair and scalp would have been within the scope of a skilled artisan because, a skilled artisan would expect the composition to be effective in conditioning the hair as well as not exert an undesirable effect (harmful effect) on the scalp and hair, with which it is in contact.

With respect to the unexpected results presented in the instant specification, applicants' claimed range of molecular weight of aminosilicones is 11000 to 25000, whereas the specification shows an unexpected result only with 50000. In order to establish the criticality of the molecular weight of aminosilicones, a proper comparison includes aminosilicones having molecular weight below 1) 11000 (lower limit), 2) 11000, 3) 25000 and 4) above 25000 (upper limit). Absent such, the unexpected result shown can only be attributed to aminosilicone with a molecular weight of 15000 but cannot be extrapolated to the claimed range.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala  
Examiner  
Art Unit 1615  
October 28, 2004